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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,493	04/19/2004	John Temple	MMC-10902/29	3298
25006	7590	03/16/2009	EXAMINER	
GIFFORD, KRASS, SPRINKLE, ANDERSON & CITKOWSKI, P.C. PO BOX 7021 TROY, MI 48007-7021			KASZTEJNA, MATTHEW JOHN	
ART UNIT	PAPER NUMBER			
			3739	
MAIL DATE	DELIVERY MODE			
03/16/2009	PAPER			

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOHN TEMPLE

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Appeal 2009-0012<sup>1</sup>  
Application 10/827,493  
Technology Center 3700

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Decided:<sup>2</sup> March 16, 2009

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Before TONI R. SCHEINER, DONALD E. ADAMS, and FRANCISCO C.  
PRATS, *Administrative Patent Judges*.

PRATS, *Administrative Patent Judge*.

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<sup>1</sup> John Temple is the real party in interest (App. Br. 1 (Appeal Brief filed February 1, 2007)).

<sup>2</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

### DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a system for warming an endoscope, laparoscope, or similar instruments. The Examiner has rejected the claims as anticipated and obvious. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

### STATEMENT OF THE CASE

“In minimally invasive surgical (MIS) procedures, elongated illuminators and viewers, i.e., laparoscopes and endoscopes, are inserted through small incisions in the abdominal wall or elsewhere. The viewer is typically coupled to a video camera that shows the operating field on a monitor” (Spec. 1). Because the devices are initially at room temperature and are then placed in a warm, moist body cavity, “[a] common problem is that the lens on the viewer becomes fogged” (*id.*).

The Specification discloses “a system and associated method for warming an endoscope, laparoscope, or other such instrument to minimize fogging” (*id.* at 2). The preferred embodiment includes “a pad for wrapping around an instrument, including a one or more substances operative to generate heat through an exothermic reaction; and an activation disc located around the periphery of the pad to provide for convenient user access” (*id.* at 3).

Claims 1-4 are pending and on appeal (App. Br. 1). Claims 1 and 3 are representative of the rejected subject matter and read as follows:

1. A system for warming an endoscope, laparoscope, or other such instrument to minimize fogging, comprising:  
a flexible pad having a length, a width and a periphery for wrapping around the instrument, the pad including a

mixture of water and sodium acetate to generate heat through an exothermic reaction;

an activation disc located around the periphery of the pad; and

one or more elongate partitions running lengthwise along the pad to establish fold line, each partition including a gap to facilitate fluid transfer of the mixture.

3. The system of claim 1, further including a housing to contain the pad in sleeve form into which the instrument is inserted.

The Examiner cites the following documents as evidence of unpatentability:

Morgan	US 5,910,106	Jun. 8, 1999
Beane	US 2002/0022762 A1	Feb. 21, 2002

The following rejections are before us for review:<sup>3</sup>

Claims 1, 2, and 4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Morgan (Ans. 4-5).

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being obvious in view of Morgan and Beane (Ans. 5).

#### ANTICIPATION

#### ISSUE

The Examiner finds that Morgan anticipates claim 1 because it discloses a laparoscope or endoscope warming system having the following features:

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<sup>3</sup> The Examiner has withdrawn an obviousness rejection of claims 1, 2, and 4 over Morgan and Meckstroth (U.S. Patent No. 5,651,757 (filed February 15, 1996)), and an obviousness rejection of claim 3 over Morgan, Beane, and Meckstroth (Ans. 4).

"[A] flexible pad 21 having a length, a width and a periphery for wrapping around the instrument, the pad including a mixture of water and sodium acetate to generate heat through an exothermic reaction ([s]ee Col. 4, Lines 52-62), an activation disc 41 located around the periphery of the pad and one or more elongate partitions running lengthwise along the pad to establish fold line, each partition including a gap to facilitate fluid transfer of the mixture (see Figs 2-3).

(Ans. 4-5).

Appellant contends that in finding Morgan's device to be anticipatory, the Examiner failed to interpret claim 1 in a manner consistent with the Specification (App. Br. 3-4). Thus, Appellant argues, Morgan fails to meet all of the limitations in claim 1 because it "does not teach or suggest 'a flexible pad . . . for wrapping around the instrument.' Nor does Morgan teach or suggest 'one or more elongated partitions running lengthwise along the pad to establish fold lines, each partition including a gap to facilitate fluid transfer of the mixture.'" (App. Br. 4).

In view of the respective positions advanced by Appellant and the Examiner, the issue with respect to this rejection is whether the Examiner erred in finding that Morgan meets the limitations in claim 1 requiring the endoscope warming system to include a pad, wherein the pad has one or more elongate partitions running lengthwise along the pad to establish fold lines, each partition including a gap to facilitate fluid transfer of the mixture.

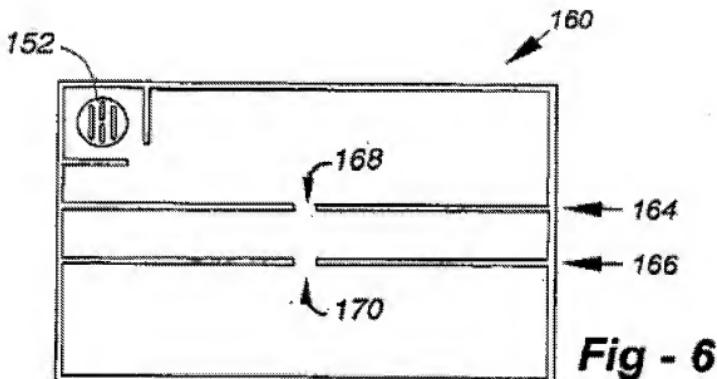
*FINDINGS OF FACT ("FF")*

1. Claim 1 recites a system for warming an endoscope, laparoscope, or other such instrument to minimize fogging. The device has a flexible pad for wrapping around the instrument, the pad including a mixture of water

and sodium acetate to generate heat through an exothermic reaction. The pad also has an activation disc located around the periphery of the pad.

Claim 1 also recites that the pad has “one or more elongate partitions running lengthwise along the pad to establish fold line[s], each partition including a gap to facilitate fluid transfer of the mixture.”

2. Appellant's Figure 6 (Replacement Drawing Sheet filed May 17, 2005) is reproduced below:



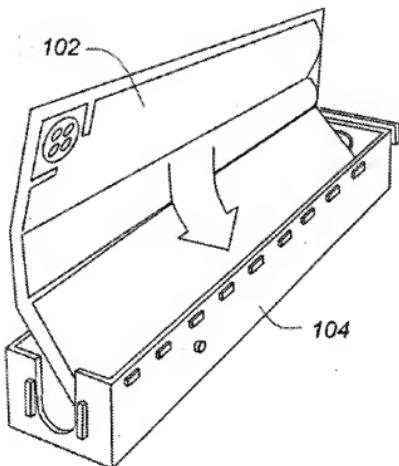
The Specification describes Figure 6 as follows:

Figure 6 is a plan view of a preferred heating pad 160 according to the invention. The pad contains a mixture of sodium acetate and water, and, unique to the invention, a particular spot 152 is provided, including a stainless steel disc to initiate the chemical reaction. . . [T]his disc is placed on the pad so that when rolled into [a] housing, the area 152 is easily accessible when the hinged lid . . . is opened. Note that the pad 160 is also otherwise partitioned along lines 164 and 166 to

*conveniently provide fold areas for easier placement into the housing . . . Gaps 168, 170 facilitate fluid transfer of the mixture.*

(Spec. 4 (as amended May 17, 2005) (emphasis added).)

3. Appellant's Figure 1 (Drawings filed September 2, 2004) is reproduced below:



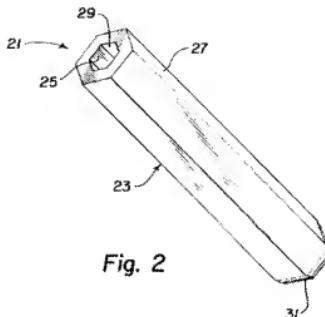
***Fig - 1***

According to the Specification, "Figure 1 is an oblique representation showing the way in which pad 102 is placed into a housing 104 without a lid or hinged access panel" (Spec. 4). Figure 1 shows pad 102 being folded into housing 104 along fold lines (not designated by reference numerals 164 and 166 shown in Figure 6).

4. Morgan discloses “an instrument heater for heating an optical scope used in laparoscopic surgery” (Morgan, col., 3, ll. 6-7). The instrument heater is essentially a sheath that surrounds the instrument, with “an inner wall forming a bore for receiving the instrument and an outer wall forming a void between the inner wall and the outer wall” (*id.* at col. 3, ll. 10-12). The sheath is open at the end that receives the instrument, and closed at the other end (*see id.*, at col. 3, ll. 15-29; *see also* Figure 2).

5. Between its inner and outer walls, Morgan’s sheath has a chemical solution, “such as food grade sodium acetate and water, which is reactive to a chemical substance for generating heat” (Morgan, col. 3, ll. 12-15). The closed-ended tip of the sheath has an activator disk with a substance, for example garnet powder, attached to the disk (*id.* at col. 3, ll. 15-18). Morgan discloses that “[w]hen the activator disk is flexed, the chemical substance is ejected from the activator disk which mixes with the chemical solution. The interaction of the chemical solution and the chemical substance results in an exothermic reaction which generates heat within the sheath” (*id.* at col. 3, ll. 18-22).

6. Figure 2 of Morgan, reproduced below, is a perspective view of Morgan’s instrument heater 21:



*Fig. 2*

Morgan's Figure 2 shows:

The instrument heater 21 includes a sheath 23. The sheath 23 has an inner wall 25 and an outer wall 27 running across the entire length of the sheath 23. The inner wall 25 and the outer wall 27 form an essentially circular bore (not shown in FIG. 1) through the center of the sheath 23. At one end of the sheath 23 is an opening 29 which serves as the beginning of the bore. At an opposite end of the sheath 23 is a tip 31. The tip 31 is closed-ended and essentially dome-shaped.

(Morgan, col. 4, ll. 35-43.)

7. Referring to Figure 2, Morgan further discloses:

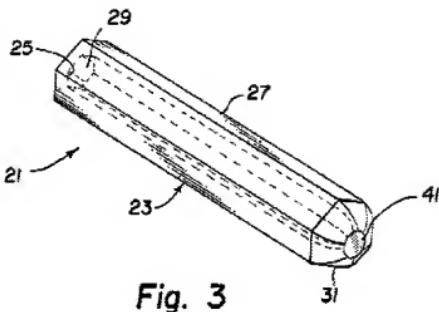
The inner wall 25 and the outer wall 27 are constructed of a flexible nonporous material allowing for the insulation of heat. In the disclosed embodiment, the material is chip board which is a thin cardboard type material which insulates the heat within the interior of the sheath 23. However, any flexible and nonporous material capable of being sterilized may be used.

Between the inner wall 25 and the outer wall 27 is a chemical solution used in forming an exothermic reaction to create heat. In the disclosed invention, a food grade sodium acetate and water solution is utilized. Other chemical solutions may be used such as calcium chloride and water to produce the desired heat. The mixed chemical solution runs between the inner wall 25 and the outer wall 27 across the entire length of

the sheath 23. Additionally, the chemical solution is present at the tip 31. The inner wall 25 and the outer wall 27 retain the chemical solution within the sheath 23.

(Morgan, col. 4, ll. 45-62.)

8. Figure 3 of Morgan, reproduced below “is a cut-away perspective view of the instrument heater 21” (Morgan, col. 4, ll. 63-64):



**Fig. 3**

Figure 3 shows “activator disk 41 . . . located between inner wall 25 and the outer wall 27 at the tip 31 and surrounded by the chemical solution” (Morgan, col. 5, ll. 1-3).

9. Figure 6 of Morgan is reproduced below:

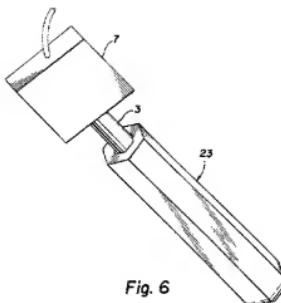
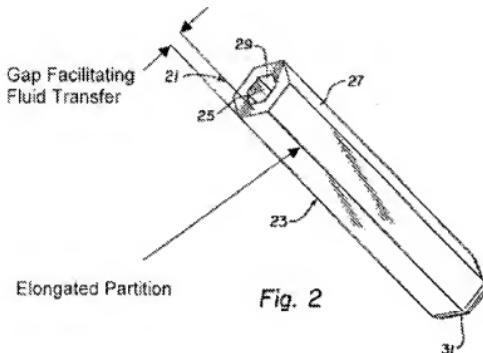


Fig. 6

Morgan's Figure 6 shows "a perspective view of the instrument heater 21 positioned on the optical scope 1 according to the teachings of the present invention" (Morgan, col. 5, ll. 37-39). Specifically, Figure 6 shows heater 21 "placed over the probe 3, covering several inches (approximately 4 to 6 inches) of the probe 3 as well as the lens 5. Upon flexing the activator disk 41, the activator disk 41 releases metal nodules which react with the sodium acetate to cause an exothermic reaction" (*id.* at col. 5, ll. 47-52).

Morgan discloses that the "sheath 23 may be massaged to induce a faster reaction by mixing more metal nodules into the chemical solution throughout the length of the sheath 23" (*id.* at col. 5, ll. 55-57).

10. In support of the position that Morgan's device meets the limitation in claim 1 requiring the device to have one or more elongate partitions running lengthwise along the pad to establish fold lines, with each partition including a gap to facilitate fluid transfer of the mixture, the Examiner provides an annotated version of Morgan's Figure 2, reproduced below (Ans. 6):



The Examiner's annotated version of Morgan's Figure 2 shows the lengthwise-running vertices of the hexagonally-shaped sheath as being the elongated partitions recited in Appellant's claim 1, and the gap between the inner wall 25 and outer wall 27 as being the "Gap Facilitating Fluid Transfer" (*id.*)

#### PRINCIPLES OF LAW

It is well settled that, for a reference to anticipate a claim "[e]very element of the claimed invention must be literally present, *arranged as in the claim.*" *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added).

It is also well settled that "[i]nherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981) (quoting *Hansgirg v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939)) (emphasis in original)).

During examination, the PTO must interpret terms in a claim using “the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

The Examiner must therefore “determine[] the scope of claims in patent applications *not solely on the basis of the claim language*, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed.Cir.2005) (emphasis added) (quoting *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)).

In addition to the Specification, Appellant’s drawings may be consulted to determine the meaning of claim terms. *See Brookhill-Wilk I, LLC v. Intuitive Surgical, Inc.*, 334 F.3d. 1294, 1294, 1298 (Fed. Cir. 2003) (“The ordinary and customary meaning of a claim term may be determined by reviewing a variety of sources. Some of these sources include the claims themselves; dictionaries and treatises; and the written description, *the drawings*, and the prosecution history.” (citations omitted, emphasis added)).

We note the well settled principle that, “while ‘the specification [should be used] to interpret the meaning of a claim,’ courts must not ‘import[ ] limitations from the specification into the claim.’ . . . [I]t is improper to ‘confin[e] the claims to th[e] embodiments’ found in the specification . . . .” *In re Trans Texas Holdings Corp.*, 498 F.3d 1290, 1299 (Fed. Cir. 2007) (quoting *Phillips*, 415 F.3d at 1323 (citations omitted,

bracketed text in internal quotes in original); *see also Sjolund v. Musland*, 847 F.2d 1573, 1581 (Fed. Cir. 1988) (“[W]hile it is true that claims are to be interpreted *in light of* the specification and with a view to ascertaining the invention, it does not follow that limitations from the specification may be read into the claims.”); *In re Bigio*, 381 F.3d 1320, 1325 (Fed Cir. 2004) (“[A]bsent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification . . . when [it] expressly disclaims the broader definition.”).

Ultimately, however, “[c]laims are not to be read in a vacuum[;] while it is true they are to be given the broadest reasonable interpretation during prosecution, their terms still have to be given the meaning called for by the specification of which they form a part.” *In re Royka*, 490 F.2d 981, 984 (CCPA 1974).

For example, in *In re Buszard*, 504 F.3d 1364 (Fed. Cir. 2007), our reviewing court concluded that it was unreasonable to broadly interpret a claim to encompass a prior art product based on the literal language of the claim where the specification and claims had “specifically state[d]” that the claims required a particular product, and where “a person of ordinary skill in the field” would have recognized that the two products were different.

#### *ANALYSIS*

We agree with Appellant that the Examiner erred in finding that Morgan meets the limitations in claim 1 requiring the endoscope warming system to include a pad, wherein the pad has one or more elongate partitions running lengthwise along the pad to establish fold lines, each partition including a gap to facilitate fluid transfer of the mixture.

We note Morgan's disclosure that its sheath is made of flexible material, including one embodiment that uses "chip board which is a thin cardboard type material which insulates the heat within the interior of the sheath" (Morgan, col. 4, ll. 47-49 (FF 7)). We also note, as the Examiner argues, that a person of ordinary skill in the art could consider a pad to be a "thin, cushionlike mass of soft material used to fill, to give shape, or to protect against jarring, scraping, or other injury" (Ans. 6).

However, the Examiner has not explained, and we do not see, how or why Morgan's sheath can be considered to be a soft cushionlike mass as required in the Examiner's proffered definition of "pad." As noted above, "[i]nherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d at 581.

We also note, as the Examiner argues, that the six vertices of Morgan's hexagon-shaped shape sheath 21 run lengthwise along the outer surface of the device (*see* FF 10; *see also* FF 6, 8, and 9). However, we do not agree with the Examiner that a person of ordinary skill would interpret the partitions recited in claim 1 as encompassing those structures.

Specifically, as seen in Appellant's Figure 6, the partitions 164 and 166 in the pad are located between fluid-containing portions of the device, and act to "partition" the fluid-containing portion of the pad into distinct sections (FF 2). In contrast, the vertices of Morgan's hexagonal sheath do not separate the fluid-containing inner portion of the sheath into distinct sections (*see* FF 6, 8).

Moreover, claim 1 requires each partition to establish a "fold line." As seen in Appellant's Figure 1, the pad can be folded along the partitions to

be placed in a housing (FF 3). While it may be true that Morgan's sheath is hexagonally shaped (*see* FF 6, 8), the Examiner does not explain how or where Morgan discloses that the sheath can, or should, be folded along the vertices of the hexagon. We do not agree with the Examiner that a hexagonal shape necessarily creates a fold line. For example, the hexagonal head of a metal bolt could not, as a practical matter, be folded. Thus, we do not agree with the Examiner that Morgan meets the limitation requiring the partitions to establish fold lines in a pad.

In sum, for the reasons discussed above, we do not agree with the Examiner that Morgan meets the limitations in claim 1 requiring the endoscope warming system to include a pad, wherein the pad has one or more elongate partitions running lengthwise along the pad to establish fold lines, each partition including a gap to facilitate fluid transfer of the mixture. We therefore reverse the Examiner's rejection of claim 1, and its dependent claims 2 and 4, as anticipated by Morgan.

#### OBVIOUSNESS

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being obvious in view of Morgan and Beane (Ans. 5). The Examiner concedes that Morgan does not disclose a housing that contains the heating pad, as recited in claim 3, and cites Beane as disclosing the claimed housing (*id.*).

Claim 3 depends from claim 1, and includes all of the limitations of claim 1. As discussed above, Morgan fails to meet all of the limitations of claim 1. Because the Examiner has not explained, and we do not see, how Beane remedies the deficiencies of Morgan, we also reverse the Examiner's rejection of claim 3 as being obvious over Morgan and Beane.

**SUMMARY**

We reverse the Examiner's rejection of claims 1, 2, and 4 under 35 U.S.C. § 102(b) as being anticipated by Morgan.

We also reverse the Examiner's rejection of claim 3 under 35 U.S.C. § 103(a) as being obvious in view of Morgan and Beane.

**REVERSED**

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